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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/898,702 | 07/02/2001 | Benjamin W. Slivka | 3382-59319 | 4420 |

7590

08/26/2002

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EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,702

Applicant(s)

Slivka et al.

Examiner

Robert B. Harrell

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2152

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/2/01 et al.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-38 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See attached

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-27 and 36, drawn to a client computer for downloading and installing software from a server via a network or portable media classified in Class 717, subclass 176.

II. Claims 28-35,37 and 38, drawn to storing in a file software to be distributed to remote computers via a network or portable media, classified in Class 717 subclass 168.

2. Inventions I and II are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention I has separate utility such as in a system which does not have a file for storing software to be distributed to remote computers.

3. Inventions II and I are related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In this instant case, invention II has separate utility such as in a system that does not have a client computer for downloading and installing software from a server.

4. Also an undue burden would be placed upon examiner since the

search for Group I would be in class 717 subclass 176 and such a search is not required for Group II. Also the search for Group II would be in class 717 subclass 168 which is not required for Group I.

5. Because these inventions are distinct for the reasons given above and because they have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter and the search for each Group is not required for the other Group, restriction for examination purposes as indicated is proper.

6. On first inspection the two invention might appear jointed into one invention in that a client downloads from a server software to be install and executed on the client computer. However, up closer inspection of the two invention, the first invention is focused and restricted to the functions on the client side which is an invention unto itself while the other invention focused and restricts itself to the functions of the server providing a database of software which is another invention unto itself. Thus, while the two inventions might appear the same, one is directed only to the client while the

other is directed to the server and thus two inventions. While automobiles have engines, an automobile is not the same as an engine, even if one is in the other, since the automobile could be powered by either a combustible engine or electrical engine and the engines themselves could be used in things other than automobiles. In this case one invention is directed to a client obtaining and installing software and not so much as for providing a database of software while the server is directed to storing a database of software for consumption by clients and not so much for installing the software onto the server. Thus one invention is client based, the other server base. Those skilled in the art know that a client is different than a server in direct function (ie., user and provider of the Internet). Thus, in conclusion, Invention I is client based activities while Invention II is server based activities.

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. The applicant is also advised that the response must be submitted to the Office within 30 calendar days.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

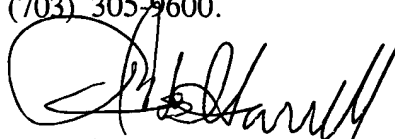
10. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read "R. B. Harrell", is written over a circular stamp area.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2152